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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/615,370

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Brooke Smith

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08/30/2004

HEWLETT-PACKARD COMPANY

Intellectual Property Administration

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EXAMINER

NGUYEN, LAM S

ART UNIT

PAPER NUMBER

2853

DATE MAILED: 08/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,370

Applicant(s)

SMITH ET AL.

Examiner

LAM S NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 20-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-18, 20-27 and 29-42 is/are rejected.
- 7) ☒ Claim(s) 7, 8 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claim 1 is rejected under the judicially created doctrine of double patenting over claim 13 of U. S. Patent No. 6655797 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

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Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 31 and 36 recite the limitation “N”. There are insufficient antecedent basis for these limitations in the claims. (*Note: Claims 31 and 36 contain the allowable figure as referring to claim 28. Therefore, there is no rejection based on prior art applied to claims 31 and 36.*)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 9-10, 12, 15-18, 20-24, 29, 32-33, 37, 39, 40, and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Kato et al. (US 6439708).

Kato et al. disclose an inkjet printing system, comprising:

at least one ink printhead for depositing drops of a colored ink on a medium (*FIG.*

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5: *four heads 1 contain nozzles 22, 23, 24, 25) including a black printhead, a cyan printhead, a magenta printhead, and a yellow printhead (FIG. 5 and column 19, line 55-65) (Referring to claim 12);*

a fixer printhead for depositing drops of a fixer onto the deposited drops of the colored ink (FIG. 5: head 1b contains nozzles 21 for ejecting the second liquid; column 3, line 65-67: “depositing a second liquid containing a reactant, which forms coagulate upon contact with the ink composition, onto the recording medium, separately before or after the deposition of the ink composition or the first liquid”);

an overcoat printhead for depositing drops of an overcoat onto the deposited drops of the colored ink (FIG. 5: head 1d contain nozzles 26 for ejecting the first liquid; column 19, line 5-10 and Abstract: “after printing of an ink composition, the application of the first liquid to form a coating”), wherein the fixer and overcoat printheads are half-height (FIG. 2, the head 1b is half-height the height of the whole head) (Referring to claims 1, 15, 21, 29, 32-33, 37, 42). (Note: Because claims 21, 29, 32, 33, 37, and 42 are method of using apparatus claims, the limitation “wherein the fixer and overcoat printheads are half-height” does not contribute to the steps in the process. Thus, the limitation is considered but not given patentability weight).

Referring to claims 2-4, 15, 21-24, 29, 32-33, and 42: further comprising a processor for generating and sending swath data to each ink, fixer, and overcoat printhead during printing (FIG. 3: *a corresponding processor or a computer controller with a memory for generating and sending swath data to print a ink swath 32 and a overcoat swath 31).*

Referring to claim 9: further comprising at least one additional fixer or overcoat printhead for bi-directional printing (FIG. 6, *element 40a-b, 41a-b and column 22, line 40-57).*

Referring to claims 10, 37: wherein the drops of the fixer and the drops of the overcoat combine on the medium to form a protective coating for the drops of the colored ink (*column 3, line 60 to column 4, line 5: the first liquid and the second liquid are both deposited on the recording medium*).

Referring to claim 15: comprising a carriage assembly moveable in a scanning direction for carrying at least one inkjet printhead, a fixer printhead, and an overcoat printhead (*FIG. 1, element 4*).

Referring to claim 16: wherein the carriage assembly provides in-line arrangement of all printheads such that colored ink, the fixer, and the overcoat are deposited in substantially the same rows of a print medium as the carriage assembly moves in the scanning direction (*Fig. 6*).

Referring to claim 17: wherein the carriage assembly provides a staggered arrangement of the printheads such that the fixer and the overcoat are deposited in substantially different rows of a print medium from the colored ink as the carriage assembly moves in the scanning direction (*Fig. 5*).

Referring to claim 18: wherein the fixer printhead is located at one end of the in-line arrangement of inkjet printheads, and the overcoat printhead is located at the opposite end of the in-line arrangement (*FIG. 6, elements 40a-b, 41a-b*).

Referring to claim 20: wherein the overcoat and fixer printheads are in a separate row from the ink printheads (*FIG. 5*).

Referring to claims 39-40: wherein the drops of the overcoat/fixer are deposited onto the deposited drops of the fixer/overcoat (*FIG. 6; column 3, line 65 to column 4, line 2; and column 22, line 36-40: The heads 41a-b eject the fixing liquid and the heads 40a-b eject the*

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overcoating liquid. Because "only the nozzles located at the backmost row in the printing direction are operated" (column 22, line 50-53), the fixing liquid ejected by the head 41a or 41b is deposited before the overcoating liquid ejected by the head 40a or 40b).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (US 6439708) in view of Otsuki (US 6145961).

Kato et al. disclose the claimed invention as discussed above except that wherein the at least one ink printhead includes a black printhead, a light cyan printhead, a light magenta printhead, a dark cyan printhead, a dark magenta printhead, and a yellow printhead.

Otsuki discloses an inkjet recording apparatus having an ink printhead including a black printhead, a light cyan printhead, a light magenta printhead, a dark cyan printhead, a dark magenta printhead, and a yellow printhead (FIG. 9) in order to prevent deterioration of the picture quality due to misalignment of dot formation positions (Column 2, line 14-20).

Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to modify the printhead disclosed by Kaito et al. such that including a black printhead, a light cyan printhead, a light magenta printhead, a dark cyan printhead, a dark magenta printhead, and a yellow printhead as disclosed by Otsuki. The motivation of doing so is

to prevent deterioration of the picture quality due to misalignment of dot formation positions as taught by Otsuki (Column 2, line 14-20).

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (US 6439708) in view of Yasunori (JP 11277724 A).

Kato et al. disclose the claimed invention as discussed above except means for delaying the depositing of the drops of the fixer and the drops of the overcoat until the drops of the colored ink have at least partially dried.

Yasunori discloses a color printer having a color printhead and a coating head, wherein after the printed matter becomes a semi-dried condition, a liquid type coating agent is coated on the printed surface in order to gain resistance to scratching (Abstract).

Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to modify the printing system disclosed by Kaito et al. such that including means for delaying the depositing of the drops of the fixer and the drops of the overcoat until the drops of the colored ink have at least partially dried as taught by Yasunori. The motivation of doing so is to obtain the printing with high resistance to scratching even on the medium W having no ink-absorption property by an ink jet method as taught by Yasunori (Abstract).

6. Claims 5-6, 14, 25-27, 30, 34-35, 38, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (US 6439708) in view of Moriyama et al. (US 6412934).

Kato et al. disclose the claimed invention as discussed above except a controller for operating the printheads in a mode in which fixer and overcoat are not deposited if the media type is specialty or deposited if the media type is plain, wherein the processor generates swath

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data for N or M contiguous groups of each printhead, where integer N (or M) >1 (or 2), wherein the processor always generates null swath data (used for printing data) for a group of ink ejection elements in each printhead, and wherein the groups contain the same number of ink ejection elements.

Moriyama et al. disclose an ink jet printing apparatus having color printheads and a quality improving liquid head to eject liquid to fix printed dots (column 3, line 57). Wherein the printer operates in different modes in accordance to the printing medium (FIG. 5). If the printing medium is plain, the fixing liquid is deposited (FIG. 5, steps 13-14); otherwise, the deposition of fix liquid is omitted (FIG. 5, step 12). Wherein the heads have ink ejection elements separated into two groups each contains a half number of a total ink ejection elements in a head (FIG. 7: a front half or a rear half of printhead 103). During a scanning in the printing direction A, only one group in each head receives data for printing, the other is not used for printing or receives null data (FIG. 7).

Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to modify the printing system disclosed by Kaito et al. such that including a controller to operate the printer in different modes in accordance to printing medium to deposit or not deposit the coating and fix liquids as disclosed by Moriyama et al. The motivation of doing so is to “provide a printing method in which an optimal process is carried out depending on the print medium type” so that a high quality image with the highest water resistance can be obtained as taught by Moriyama et al. (column 3, line 45-52).

7. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (US 6439708) in view of Allen (US 5635969).

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Kato et al. disclose the claimed invention as discussed above except that wherein active swath data is sent to only subset of ink ejection elements in the ink printhead during the first pass, and only a subset of ink ejection elements in the fixer or overcoat heads during the second pass.

Allen discloses a printing apparatus having a plurality ink printheads (FIG. 1, elements 12, 14, 16, 18) and a print head for applying a colorless precursor (FIG. 1, element 20) on the printing medium prior to application of one or more colorants to the recording medium in order to prevent recording medium cockle and curl (Abstract), wherein the colorless precursor and the ink colorants are applying on the recording medium surface in separated swaths or passes to create a spacing or separation in time to avoid the mixing between the colorless precursor and the ink colorants (column 5, lines 24-30).

Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to modify the printing system disclosed by Kaito et al. such that sending swath data to the ink ejection elements in the printhead and the fixer and the overcoat head in different passes as disclosed by Allen. The motivation of doing so is to create a spacing or separation in time to avoid the mixing between the colorless precursor and the ink colorants as taught by Allen (column 5, lines 10-30).

Allowable Subject Matter

Claims 7, 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Referring to claims 7, 28: (Assumed that “N-1” is “N=4”) The most pertinent art fails to disclose wherein N=4; wherein null swath data is always generated for the third and fourth groups of ink printing elements and wherein null swath data is always generated for the first and second groups of fixer and overcoat printhead ink ejection elements. Therefore, the claimed invention is not disclosed by the cited prior art.

Claim 8 is allowable because it depends on claim 7.

Response to Arguments

The applicants have not amended claim 36 to overcome the 112 rejection as indicated in the previous office action. Therefore, the rejection is maintained.

The applicants have amended the independent claims to contain the allowable figure indicated in the previous office action. However, because the claims are so broad that the claimed invention can be interpreted as that the fixer and the overcoat heads are half-height of the height of the whole printhead. Thus, Kato et al. still disclose the claimed invention (see the third rejection).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAM S NGUYEN whose telephone number is (571)272-2151. The examiner can normally be reached on 7:00AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, STEPHEN D MEIER can be reached on (571)272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LN
August 24, 2004


HAI PHAM
PRIMARY EXAMINER